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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,793	09/28/2001	Takatsugu Nakazawa	P21331	2871

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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,793

Applicant(s)

NAKAZAWA ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

Claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19, 20, 22- 24, 26, 27, and 29-31 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *Dragon Quest IV* by Enix America, Inc (1990) as described in Dan Gonzales, *Dragon Quest IV (NES) Manual*, (June 4, 2003).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim Rejections - 35 USC § 103

Claims 4, 11, 18 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Tanibuchi et al. U.S. Patent 6,475,084 B2 (Nov. 5, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claims 7, 14, 21 and 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Yoshikawa et al., U.S. Patent 6,347,994 B1 (Feb. 19, 2002).

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Dragon Quest IV* in view of Baker et al., U.S. Patent 6,106,399 (Aug. 22, 2000)

This holding, incorporated herein, is maintained from the prior action for the cited claims as amended. Response to the applicant's remarks are provided below and incorporated herein.

Response to Arguments

Applicant's arguments with respect to the nonstatutory double patenting rejection have been fully considered and are persuasive. *See arguments filed Jan. 26, 2004, pp.3-4.* The nonstatutory double patenting rejection of claims 7, 14, 21 and 28 has been withdrawn.

Applicant's arguments with respect to the rejection of claims 1-3, 5, 6, 8-10, 12, 13, 15-17, 19, 20, 22-24, 26, 27 and 29-31 under 35 USC § 102(b) have been fully considered but they are not persuasive.

First the applicant asserts that the rejection is improper because Gonzales is unavailable as prior art. The examiner respectfully disagrees. 35 USC § 102(b) states that a person shall be entitled to a patent unless the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. In this case, the claims are rejected under 35 USC § 102(b) for being anticipated by *Dragon Quest IV*. The reference was published and made available for sale in the United States by Enix America, Inc. in 1990. Hence, the claims are unpatentable because the features were described in a printed publication and made available for public sale in this country at least 10 years prior to the date of application for patent in the United States.

Second, the applicant asserts that the rejection is improper because the examiner has failed to establish that Gonzales is prior art. The examiner respectfully disagrees. Gonzales is not relied on as prior art. The examiner concedes that Gonzales was published on July 4, 2003. *See PTO-892 dated Oct. 24, 2003 (paper no. 9).* Nonetheless, the examiner has established that *Dragon Quest IV* was published and for sale in 1990. Gonzales provides an instruction manual describing the features of *Dragon Quest IV*. The applicant does not contend that *Dragon Quest IV* is prior art. Furthermore, the applicant does not contend that Gonzales inaccurately describes the features of *Dragon Quest IV* as released in 1990. Hence, the examiner maintains that the claimed invention was described in a printed publication in this country and

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in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Third, the applicant argues that *Dragon Quest IV* does not describe each and every feature of the claims 1, 8, 15, 22, 29, 30 and 31. In particular, the applicant asserts that the *Dragon Quest IV* does not display a list of standby characters when a player in battle is awaiting an input command that can be directly selected by a single operation by the player and substituted. The examiner respectfully disagrees. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this case, the feature of a "single operation", upon which applicant's argument relies, is not recited in the rejected claims. "An operation" does not require a single selection; instead, it may be a plurality of inputs. *Dragon Quest IV* displays a "Tactics" subscreen selectable by a player from "Command Window" menu available while the character awaits a command input. See pp. 5, 9-10. From the "Tactics" subscreen, the player can select from a list of standby characters which are substituted. See *id.* Characters can be switched during battle and will so automatically if required. See *id.* Hence, *Dragon Quest IV* teaches the features of the claims.

Consequently, for all the reasons given above the examiner maintains that claims are unpatentable as being anticipated by *Dragon Quest IV*.

Applicant's arguments with respect to the rejection of claim 32 under 35 USC § 103 have been fully considered but are unpersuasive for the same reasons given for claims 1, 8, 15, 22, 29, 30 and 31. See *supra*.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

s.a.

JOHN M. POTALING, II
PRIMARY EXAMINER